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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/666,488 | 09/19/2003 | Aziz Hassan | BSN9 | 8014 |

7590 09/07/2007
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EXAMINER

NUTTER, NATHAN M

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| ART UNIT | PAPER NUMBER |
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1711

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| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

09/07/2007

PAPER

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| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---------------------------------|-------------|---|---------------------|
| 10666488 | 9/19/03 | HASSAN ET AL. | BSN9 |

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EXAMINER

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| ART UNIT | PAPER |
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1711

20070830

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Commissioner for Patents

Nathan M. Nutter
Primary Examiner
Art Unit: 1711



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/666,488
Filing Date: September 19, 2003
Appellant(s): HASSAN ET AL.

MAILED
SEP 07 2007
GROUP 1700

Thomas L. Adams
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 18 June 2007 appealing from the Office action mailed 17 February 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTION

The following ground of rejection is not presented for review on appeal because it has been withdrawn by the examiner.

The rejection of claims 1, 3-16 and 18-27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,120,887 (Werenicz et al) is hereby expressly withdrawn.

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The rejection of claims 1, 3-16 and 18-27 under 35 U.S.C. 102(e) as being anticipated by Werenicz et al in prior Office Actions of 9 May 2005 and 17 February 2006 is being made under 35 U.S.C. 102(b).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|----------------|---------|
| 6,120,887 | Werenicz et al | 09-2000 |
| 6,552,110 | Yalvac et al | 04-2003 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1 and 3-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,552,110. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions are identical in scope and compositional limitations, possessing identical physical characteristics. Note claim 1 for the weigh percentages of constituents; note claim 2 for the densities that overlap with those recited and claimed herein. The subsequent employment of the composition as a hot-melt adhesive would have been obvious steps within the skill of an artisan. A practitioner in the art would know to use the composition in hot-melt procedures.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Yalvac et al (US 6,552,110).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1, 3-16 and 18-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Werenicz et al (US 6,120,887).

The reference teaches the production of a hot melt adhesive coating composition that may comprise up to 100 weight percent of a homogeneous interpolymer of ethylene with at least one alpha olefin having a density of 0.850 to 0.965 g/cc, overlapping with the recited "from about 40 to 100 percent by weight" and embracing the density of 0.880 to 0.930 g/cc as recited herein. The composition may include from about 40 to about 90 wt % of a tackifier resin, overlapping with that claimed herein at about 40 to about 60 percent by weight. Note the paragraph bridging column 4 to column 5 for the utility. Note claim 1, column 7 (lines 4-16), column 12 (lines 22-38), column 14 (lines 16-24 and 35-52) and the Examples. Further note the paragraph bridging column 5 to column 6, column 2 (lines 24-48) and column 4 (lines 46 et seq.) for the teachings of the hot melt

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adhesive. Note column 12 (lines 33-37) for the number average molecular weights employed, including those recited and claimed herein, and to column 12 (lines 23-28) for the Brookfield viscosities, which clearly include those recited and claimed herein. As regards the adhesive properties such as Peel Adhesion Failure Temperature or Shear Adhesion Failure Test, the reference provides the identical composition with the identical number average molecular weight used in identical compositional limitations, and would inherently produce and possess these characteristics. Nothing is recited to indicate, or otherwise provide reasoning, why the reference does not show all elements of the claimed invention.

(10) Response to Argument

Appellants contend in the amendment filed after the Final rejection that "this assumption that the present pending application is owned by the same entity (Dow Chemical Company, "Dow") that owns the Yalvac et al and Werenicz et al patents (Office Paper 0206, page 4, referring to the two references as having a common assignee with the present pending application) is erroneous. Appellants assert that since "(t)he Yalvac et al. patent is assigned to both Dow Global Technologies, Inc., Midland, MI and to Nor-Skilt, Moss, Norway" appellants contend, it would have been "inappropriate under the circumstances of this case" to file a Terminal Disclaimer thereover. It is pointed out that while the patent and the instant application do not share common ownership, the application of the rejection of the claims under the judicially-created doctrine of obviousness-type double patenting is still applicable since the

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instant application and the the Yalvac et al and Werenicz et al patents share the inventor, Teresa Karjala, regardless to whom the assignments have been made.

With regard to the rejection of the claims 1 and 3-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,552,110 to Yalvac et al, it is pointed out that the employment of the composition would, indeed, be known as useful to a skilled artisan as a hot melt adhesive on its own. However, the reference teaches this very concept at column 1 (lines 11-20). More specifically note column 3 (lines 52-58), "*(t)he adhesives of the invention,*" column 5 (lines 26-47), "*adhesive formulation,*" and especially at column 7 (lines 48-53), "*the hot melt adhesives.*" It is not understood what more motivation a skilled artisan would need. Applicants respond to the double patenting rejection as though it were made in a scientific void, without having carefully and factually examining the reference to which the rejection is applied. Contrary to appellants' assertions, the suggestions and motivations are certainly provided by the teachings of the reference. Even if the composition was disclosed as only for use as a marking composition, as alleged by appellants, there would still be the need for the adhesive characteristics in order to be binding (or adhesive). Appellants provide voluminous legal arguments to establish the inappropriateness of the rejection and then state, "(f)ollowing these rules for claim construction, and using the disclosure to clarify the present pending claims, it is clear that the compositions of the pending claims are different from those of the references. Although there may be some similarities in density and molecular weight, the inventive ethylene/alpha-olefin interpolymers are still different from those

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described in the reference because of the novel manner in which these ethylene/alpha-olefin interpolymers were produced, using multiple catalysts that produce polymers with either a high or a low molecular weight, in contrast to the polymers described in the reference.” The instant claims are drawn to a product, which is not a product-by-process. As such, it is not a suitable basis for argument. The reference shows the identical product. Patentees need not recognize any inherent features at the time of their invention. The rationale put forth above explains why the products may be identical and, thus, possess the same characteristics as recited. Note *In re Best* 562 F. 2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). The burden of proof to show otherwise shifts to appellants. Note *In re Fitzgerald* 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

As regards the rejection of claims 1 and 3-15 under 35 U.S.C. 102(e) as being anticipated by Yalvac et al, the reference clearly teaches and suggests the use of the composition as a hot melt adhesive. Appellants fail to point out how this is not so, especially since the patent teaches such. Again it is pointed out that a reference is viewed for its entirety, and not for isolated passages cited in an attempt to confer patentability on the claims. Appellants' assertions that the reference fails to teach the “other properties claimed” are not correct nor are they based on factual information. The reference teaches the use of “ultra low molecular weight ethylene alpha olefin copolymers” at column 9 (lines 11-19). The reference then defines such at column 5 (lines 26-36) as having a number average molecular weight less than 11,000, which includes those recited and claimed herein. Since all compositional limitations, including the number average molecular weight, are taught, the compositions are essentially

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identical. These identical compositions would have identical inherent characteristics, which include the PAFT and SAFT values, as well as the Brookfield viscosity which would be a function of the number average molecular weight. Since the values disclosed for number average molecular weight are shown by the reference, the other inherent characteristics recited would, likewise, be present. Patentees do not have to teach values for each and every inherent characteristic for that characteristic to be present. Appellants haven't shown on the record why these characteristics wouldn't be inherent. Contrary to appellants' assertions, the reference is deemed to show all elements of the claimed invention. Appellants assert that since "the patent and the instant application do not share common ownership," the application of the rejection of the claims under 35 U.S.C. 102(e) is not proper. This rejection is still deemed proper since the instant application and the the Yalvac et al and Werenicz et al patents share the inventor, Teresa Karjala, regardless to whom the assignments have been made. Appellants argue that "(e)ven assuming that the Yalvac et al. reference was appropriate under other sections of 35 U.S.C. §102, Applicant (sic) maintains that it would not be a proper reference because of the manner of production of the ethylene/alpha-olefin interpolymers employed in the present pending application. This is not deemed to be a suitable basis for argument since the instant claims are drawn to a product, which is not a product-by-process. Appellants argue, but fail to show, how the claimed resin composition differs from that of the reference. Appellants argue that since the properties of densities and molecular weights may differ, one of skill in the art would not be guided to produce the instantly claimed composition. This is not deemed to be relevant since a

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reference is taken for the entirety of its teachings, not for isolated passages or teachings relied upon to assert patentability. The fact that an artisan *may* produce a composition outside of the scope of the instantly claimed invention is overshadowed by the fact that the identical composition is, indeed, within the confines of the reference, as pointed out. Again, patentees need not recognize any inherent features at the time of their invention. The rationale put forth above explains why the products may be identical and, thus, possess the same characteristics as recited. Note *In re Best* 562 F. 2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Note *In re Best* 562 F. 2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). The burden of proof to show otherwise shifts to appellants. Note *In re Fitzgerald* 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

As regards the rejection of claims 1, 3-16 and 18-27 under 35 U.S.C. 102(b) as being anticipated by Werenicz et al (US 6,120,887), the assignment and the inventorship is not deemed to be relevant since the reference is properly available under 35 U.S.C. 102(b). Appellants argue that "(e)mbodiments of the claimed invention were developed pursuant to a joint research agreement that was in effect on or before the date the claimed invention was made, and the claimed invention was made as a result of activities within the scope of the joint research agreement, as stated previously. Therefore, under 35 U.S.C. §103(c), the Werenicz et al. reference does not constitute prior art that would preclude patentability of the pending claims." This is deemed to be erroneous since the reference has an issue date more than one year prior to the filing date of the instant application. Appellants then contend "(a)ssuming that the Werenicz et al. reference is appropriate under other sections of 35 U.S.C. §102, Applicant

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maintains that it is an improper references because of the manner of production of the ethylene/alpha-olefin interpolymers employed in the present pending application."

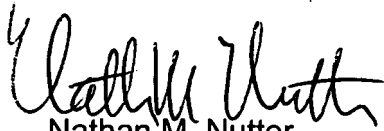
Again, this argument is hollow since the claims are drawn to a composition, per se.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Nathan M. Nutter
Primary Examiner
Art Unit 1711

Conferees:


Romulo Delmendo
James Seidleck

APPEAL CONFERENCE: _____